

REMARKS

Claims 2-3, 6-10, 12-22, 24-41, and 47-56 are pending, with claims 2, 16, 24, 31, 39 and 45 being independent. Reconsideration and allowance of the above-referenced application are respectfully requested.

Provisional Double Patenting Rejection

Claims 2-3, 6-10, 12-22, 24-41, and 47-56 stand rejected on the ground of nonstatutory obviousness-type double patenting as allegedly being unpatentable over claims 1-57 of copending Application No. 10/699,124. This rejection is respectfully traversed.

In the last Response, it was noted that the provisional double patenting rejection is improper because it fails to fully determine the differences between the scope of the claims in the current application and those in Application No. 10/699,124, as required by MPEP 804(II)(B)(1). In support of this argument, an example comparison between previously cancelled claim 1 of the present application and claim 52 in Application No. 10/699,124 was provided. The Office now states:

Applicant's attempt to show the parallel between the claims of the present application and the copending application by using only claim 52 is in error because the rejection is pertained to all the claims of the copending application.

Examiner shows an exemplary analysis with claims 52 and 54[.]

See 11/16/2007 Office Action at page 2. However, far from being in error, the previous Response merely refutes the Office's double patenting contention using the same example claim used by the Office. Moreover, if the double patenting rejection is in fact based on all the claims of the copending application, as asserted by the Office, then the Office has even more

egregiously failed to meet its duty to fully determine the differences between the scope of the claims in the current application and those in the copending application, as **required** by MPEP 804(II)(B)(1), because the Office has not determined the scope of all the claims in Application No. 10/699,124, as admitted by the Office.

In addition, as noted in the last Response, the provisional double patenting rejection does not meet the one-way obviousness standard, as set forth in MPEP 804(II)(B)(1)(a) (“whether the invention defined in a claim in the application would have been [...] an obvious variation of the invention defined in a claim in the patent”), since the Office has ignored elements of claims 52 and 54 of Application No. 10/699,124. Under a one-way obviousness-type double patenting rejection, the Office **must** consider these differences between the scope and content of the claims in the respective cases and explain why it would be obvious to remove such limitations from the other application’s claims, in addition to adding the new limitations of the present application’s claims. In response, the Office now states:

Examiner respectfully disagrees because if the application to be examined has broader claims than those that are present in the copending application and all the claim limitations are disclosed in the copending application, *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ2d 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ2d 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ2d 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ2d 644 (CCPA 1969), the claims can be rejected by obviousness double patenting rejection.

See 11/16/2007 Office Action at pages 2-3.

However, it is respectfully pointed out that the present application **does not have** “broader claims than those that are present in the copending application” because the pending

claims include limitations that are not present in the claims of Application No. 10/699,124.

Moreover, the generalized citations to *In re Goodman*, *In re Longi*, *In re Van Ornum*, *In re Vogel* and *In re Thorington*, fail to provide explicit support for the alleged holdings of those cases, and the asserted use of the disclosure of the copending application is improper. As explicitly noted in the Manual of Patent Examination Procedure (MPEP):

When considering whether the invention defined in a claim of an application would have been an obvious variation of the invention defined in the claim of a patent, the disclosure of the patent may not be used as prior art. *General Foods Corp. v. Studiengesellschaft Kohle mbH*, 972 F.2d 1272, 1279, 23 USPQ2d 1839, 1846 (Fed. Cir. 1992).

See MPEP 804(II)(B)(1). In other words, the fact that copending Application No. 10/699,124 **discloses** an element of a claim in the present application is irrelevant to a double patenting rejection if the copending Application No. 10/699,124 does not also **claim** that element, as is the case here.

Finally, as noted in the last Response, even if a revocation list were to include information regarding other document(s) that can be substituted for the revoked document(s), the natural use of such information would be to advise the user of the newer document, not to **force** the previously requested action with respect to the newer document. In response to this argument, the Office states:

Examiner respectfully disagrees because since the associated document-permissions information along with the revocation list indicate a newer document, the server is operable to relate the information concerning the third electronic document to the client to **facilitate** the action to be taken to the newer document instead as claim 54 suggests.

See 11/16/2007 Office Action at page 3 (emphasis added). However, the present claims **do not** state that the action is **facilitated** with respect to the second document, but rather that the action is **forced** with respect to the second document. This difference has not been addressed by the Office.

For all of the above reasons, and the reasons presented in the last Response, the subject matter of the present claims would not have been an obvious variation of the subject matter of the claims of Application No. 10/699,124 since the claims in the respective cases include substantial differences, which have not been addressed by the Office, and which correspond to separately patentable inventions. Thus, withdrawal of the provisional double patenting rejection is respectfully requested.

Rejections under 35 U.S.C. §§ 102 & 103

Claims 2-3, 6-10, 12-22, 24-41, and 47-56 stand rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by US Patent Publication US2002/0087876 to Larose. This contention is respectfully traversed.

Independent claim 2 is directed to controlling access to distributed documents. Claim 2 recites:

receiving a request to take an action with respect to a distributed electronic document;

identifying, in response to the request, information associated with the distributed electronic document, the associated information indicating a second electronic document different from the distributed electronic document; and

imparting information concerning the second electronic document to force the action to be taken with respect to the second electronic document;

wherein receiving the request comprises receiving, at a server, the request from a client to take the action with respect to the distributed electronic document, wherein the distributed electronic document is retained locally at the client, identifying the associated information comprises identifying associated information at the server, and imparting the second document information comprises relating the second document information from the server to the client.

See Claim 2 (emphasis added). Thus, the client sends a request to the server when an action is to be taken with respect to a distributed document that is retained locally at the client, and the server identifies the associated information at the server and sends back the second document information to the client to force the action to be taken with respect to the second electronic document.

Larose fails to teach or suggest this subject matter as claimed. As addressed in the last Response, the receiving and identifying operations in Larose all occur at the “execution processor 250” (i.e., the client computer), and although paragraph 92 in Larose does describe contacting a server, this is done with respect to the “decisions about making the next levels available”, which is referring to authorization and e-cash capabilities. In response to these points, the Office now states:

Examiner respectfully disagrees because the office action clearly states, “Larose discloses identifying the associated information (user identification and version of the document comprises identifying associated information retained at the server (see page 4, paragraph 54 and page 6, paragraph 84).” It is noted that Examiner did not interpret identifying information as attributes as argued by applicant.

See 11/16/2007 Office Action at page 3. Thus, the Office appears to suggest that Larose teaches identifying user information and document version information at the server, and that this satisfies the limitations of claim 2. This contention should be reconsidered.

First, with respect to “user identification”, as identified by the Office, this does not teach the claimed subject matter because this “associated information” does not indicate “a second electronic document different from the distributed electronic document”, as recited in claim 2. Second, with respect to “version of the document” information, as identified by the Office, this does not teach the claimed subject matter because this “associated information” is identified in response to a request for the software to be installed (at which point the software has not yet been downloaded to the client computer). *See* Larose at ¶ 84. Thus, this “identifying” in Larose, is not done in response to “a request to take an action with respect to a distributed electronic document [...] retained locally at the client”, as recited in claim 2.

Furthermore, in the last Response, it was noted that the fact that a next level/version of the software exists is already known at the client computer, and the determination that this next level/version of the software can be installed because the relevant attribute(s) have been identified on the computer has already been performed at the client computer. In response to this argument, the Office states:

Also, regarding applicant's argument that the next level/version exists in the client computer, as Examiner indicated during the interview, Larose clearly states, (paragraph 102) “Those persons of ordinary skill in the art will also recognize it is not essential that executable files corresponding to all of the versions of the software be loaded and installed at once.” And paragraph 103, lines 1-2 added, “Optionally, only the executable file for the first version 310 need be loaded and installed.”

See 11/16/2007 Office Action at page 4 (emphasis added). However, the Office has misconstrued the prior argument here. It was not argued that “the next level/version exists in the client computer”, but rather that, “the fact that a next level/version of the software exists is

already known at the client computer.” It is implicit in Larose’s entire disclosure that the client computer must first include software that has knowledge of the next level/version since the whole reason for running the inspection and binding function is to see if the known next level/version can be installed. *See* Larose throughout.

Moreover, the portion of Larose cited by the Office fully supports the argument presented in the last Response. As stated in Larose, the executable file for the first version 310 needs be loaded and installed before the second version can be installed, because it is the first version that includes the inspection function needed to determine whether the second version can be installed. *See* Larose at ¶s 102 and 103. When the second version in Larose is kept at the server (and not downloaded along with the first version), this second version is downloaded and run in response to the output of the inspection function. The information about this second version is not identified in response to “a request to take an action with respect to a distributed electronic document [...] retained locally at the client”, as recited in claim 2, since the information about the second version is identified well before the first version is downloaded to the client.

Larose describes a system for providing security for programs installed in a computer in which:

the original program is divided into versions of increasing functionality and in which higher functioning versions depend upon and utilize security-related attributes of the computer on which the program is to be executed. [...] Upon initiation of execution of the lowest functioning version, the security-related attributes of the user's computer are inspected and the execution of the second version is initiated in the place of the first version if the security-related attributes of the second computer support the increased functionality of the second version. If so, the security-related attributes are used in the second version prior to

execution. In either case, the remaining version is then executed without the need for further intervention for security purposes.

See Larose at page Abstract (emphasis added). The inspection of attributes is performed at the user's computer, and if the inspection identifies relevant attribute(s), the next higher version of the software is loaded before the user's computer runs the binding functions for that next higher version. See Larose at FIGs. 1, 2, 3 and 5, and corresponding description.

Larose fails to teach or suggest linking a document distributed to a client computer with a server such that, when an action is requested with respect to the distributed document, the server is contacted to check if the server has access to information associated with the distributed document, which information specifies a second document that the requested action should be applied to, rather than the distributed document. Thus, for all of the above reasons, independent claim 2 should be allowable over Larose.

Independent claim 24 should also be allowable over Larose for the same reasons as claim 2. Dependent claims 3, 6-10, 12-15, 25-30, and 48-51 should be allowable based on the above arguments and the additional recitations they contain. For example, claims 7 and 27 recite, "wherein the second electronic document comprises a later version of the distributed electronic document, and the associated information comprises document-permissions information specifying that the action is not permitted with respect to the distributed electronic document at the client." (Emphasis added.) The Office now provides as a basis for rejecting these claims:

(see paragraphs 54, 55, 82, and 92, user identification, completion of e-cash transaction, success code or security token specifying that the additional game

levels, increased functionality, or file read operations with respect to the first version are not permitted).

See 11/16/2007 Office Action at pages 9 and 14. None of these constitute document-permissions information specifying that an action is not permitted with respect to the first version in Larose. In fact, Larose explicitly states that the first version is made freely available and is “unrestricted in distribution and use.” *See* Larose at ¶ 53. Moreover, the reference to “file read operations” has nothing to do with document-permissions information, but rather relates to intercepting file read operations as a security measure to restrict a current program instance to “execution only on the specific computer, or, absent other bindings, only on a computer with the specific smart-card present.” *See* Larose at ¶s 80-82. This has no relation to the claimed subject matter. Thus, claims 7 and 27 should be allowable for at least these additional reasons.

Claims 8 and 48 recite, “wherein the document-permissions information specifies access permissions at a level of granularity smaller than the distributed electronic document.”

(Emphasis added.) Larose neither teaches nor suggests the subject matter of these claims, and the cited portions of Larose fail to support the rejection of this claimed subject matter. The Office states, “granularity can be for instance, a game level, increased functionality, enhanced engine, additional file, etc.” *See* 11/16/2007 Office Action at pages 9 and 18. With all due respect, these cited aspect of Larose relate to features of the next level/version of the software program, not different portions of the first version of the software program. The Office appears to be blurring the distinction between the first version of the program in Larose (which has been equated by the Office with the distributed electronic document recited in independent claims 2 and 24) with the overall set of executable files 310, 320, 330 in Larose. This is improper in light of the current interpretation of independent claims 2 and 24 with respect to Larose, and nothing

in Larose describes document-permissions information that specifies **access permissions**, for the first program version in Larose, at a level of granularity **smaller** than the first program version.

Thus, claims 8 and 48 should be allowable for at least these additional reasons.

Claims 9 and 28 recite, “wherein the associated information comprises user-dependent association information indicating the second electronic document, and obtaining the second electronic document comprises identifying the second electronic document based on the user-dependent association information and an identified user at the client.” (Emphasis added.)

Larose neither teaches nor suggests the subject matter of these claims, and the cited portions of Larose (§s 54, 62, and 66-67) fail to support the rejection of this claimed subject matter.

Paragraph 54 in Larose describes making a second version available “to users in return for obtaining personal information about the user, which can be used for targeted marketing purposes.” Paragraph 62 in Larose describes using a smart-card reader to identify the user.

Paragraphs 66-67 in Larose describe downloading the versions of the software product to users and providing a mechanism to permit the e-cash transaction required to permit access to the third version of the software product. None of these portions of Larose describe identifying information associated with a distributed electronic document, where this associated information indicates a second electronic document in a **user-dependent** fashion, and where the second document is identified **based on the user-dependent association information** and an identified user at the client. To the contrary, the second and third versions provided in Larose do not vary with the identified user, but rather, are the same for all users. Thus, claims 9 and 28 should be allowable for at least these additional reasons.

Claims 10 and 29 recite, “wherein obtaining the second electronic document further comprises generating at least a portion of the second electronic document based on the identified user.” (Emphasis added.) Larose neither teaches nor suggests the subject matter of these claims, and the cited portions of Larose (§s 54, 62, 66-67, and 104) fail to support the rejection of this claimed subject matter. Paragraphs 54, 62, and 66-67 are addressed above, and it should be clear that these do not describe generating at least a portion of the next versions of the software product **based on the identified user.** Paragraph 104 does note that the URL could be different for different users, but the URL does not constitute a portion of the versions of the software product in Larose. Thus, claims 10 and 29 should be allowable for at least these additional reasons.

Claims 15 and 51 recite, “wherein the second document includes the address of the server and a second document identifier, and replacing the distributed document further comprises writing over the distributed document with the second document in a storage device.” (Emphasis added.) Larose neither teaches nor suggests the subject matter of these claims, and the cited portions of Larose (§s 55 and 89) fail to support the rejection of this claimed subject matter. Paragraph 55 in Larose mentions that an enhanced game engine can replace the basic game engine of the first version 110 and second version 120, but does not state that either of the first and second versions are over written in a storage device. One of ordinary skill in the art would recognize that the described “replacement” merely refers to updating a dynamic link for a sub-component of the software, not overwriting an entire earlier version of the software. Paragraph 89 in Larose describes allowing the process corresponding to the execution of the first version to die, but says nothing about what happens to the first version saved in a storage device. One of

ordinary skill in the art would recognize that terminating a running process for a piece of software is not equivalent to over writing the software itself in a storage device. Thus, claims 15 and 51 should be allowable for at least these additional reasons.

Independent claims 16 and 31 should also be allowable over Larose for at least reasons similar to claim 2. In particular, claims 16 and 31 recite, “opening a locally retained distributed document; contacting a document control server identified from the distributed document; and forcing use of a second document in place of the distributed document, with respect to at least one document action, based on information received from the document control server.” (Emphasis added.) In addition, nothing in Larose suggests contacting a document control server, as claimed. It is noted that a “document control server” is not equivalent to any “server” generally, as suggested by the Office. *See* 11/16/2007 Office Action at page 4. Thus, for all of the above reasons, independent claims 16 and 31 should be allowable over Larose.

Dependent claims 17-22, 32-38, and 47 should be allowable based on the above arguments and the additional recitations they contain. For example, claims 20 and 35 recite, “wherein forcing use further comprises transparently overwriting the distributed document with the second document.” (Emphasis added.) Claims 21 and 36 recite, “wherein the received information comprises document-permissions information specifying permissions relating the second document with the distributed document.” (Emphasis added.) Claims 37 and 47 recite, “wherein the document-permissions information specifies access permissions at a level of granularity smaller than the distributed document.” (Emphasis added.) Larose neither teaches nor suggests the subject matter of these claims, and the cited portions of Larose fail to support the rejection of this claimed subject matter for the reasons similar to those detailed above.

Independent claim 39 should also be allowable over Larose for at least reasons similar to claim 2. In particular, claim 39 recites, “a client operable to send a request to a server when an action is to be taken with respect to a distributed electronic document local to the client; and a server operable to receive the request, and in response to the client, the server being operable to identify information associated with the distributed electronic document, the associated information indicating a second electronic document different from and associated with the distributed electronic document, the server being operable to relate information concerning the second electronic document to the client to force the action to be taken with respect to the second electronic document.” (Emphasis added.) Thus, for the reasons related above, independent claim 39 should be allowable over Larose. Dependent claims 40, 41, and 52-56 should be allowable based on the above arguments and the additional recitations they contain. For example, claims 52, 53, 54, 55, and 56 should be allowable for at least reasons similar to claims 7, 8, 9, 10, and 15, respectively.

Conclusion

The foregoing comments made with respect to the positions taken by the Examiner are not to be construed as acquiescence with other positions of the Examiner that have not been explicitly contested. Accordingly, the above arguments for patentability of a claim should not be construed as implying that there are not other valid reasons for patentability of that claim or other claims.

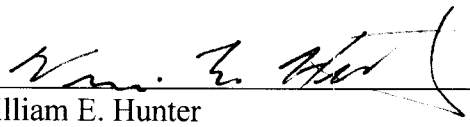
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A notice of allowance is respectfully requested. Please apply the \$810 Request for Continued Examination fee, and any other charges or credits, to deposit account 06-1050.

Respectfully submitted,

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